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09/731,163

12/06/2000

Dan Candura

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7590

06/24/2004

EXAMINER

ROBINSON BOYCE, AKIBA K

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PHOENIX, AZ 850040001

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/731,163

Applicant(s)

CANDURA ET AL.

Examiner

Akiba K Robinson-Boyce

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 051601.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. This communication is in response to communications filed 12/6/00. This is a first non-final office action. Claims 1-17 are pending in this application and have been examined on the merits. Claims 1-17 are rejected as follows.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful art" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 is directed to a method for evaluating the performance of a financial advisor. Claim 1 recites the steps of “reading a case prepared by the financial advisor, wherein said case provides recommendations”, “assigning a numerical value for said case in each of said plurality of areas based on said rating”. These steps represent mere ideas in the abstract since no computer means or software embodied on a tangible medium exist for processing the steps of the claim. Since no computer means or software embodied on a tangible medium exist for processing the steps of the claim, claim 1, and all claims that depend from it, (claims 2-12) are therefore found to be non-statutory.

In the present case, claim 13 is directed to a method for evaluating the performance of a financial advisor. Claim 13 recites the steps of “selecting a case prepared by the financial advisor, wherein said case provides recommendations”, “selecting a first assessor and a second assessor”, “rating said case in a plurality of areas by comparing said case to a predetermined standard”, “assigning a first numerical value for said case in each of said plurality of areas based on said rating by said first assessor”, “assigning a second numerical value for said case in each of said plurality of areas based on said rating by said second assessor”, “comparing said first numerical value to said second numerical value in one of said plurality of areas”. These steps represent mere ideas in the abstract since no computer means or software embodied on a tangible medium exist for processing the steps of the claim. Since no computer means or software embodied on a tangible medium exist for processing the steps of the

claim, claim 13, and all claims that depend from it, (claim 14) are therefore found to be non-statutory.

In the present case, claim 15 is directed to an evaluation system used to measure written work-product. Claim 15 recites the steps of “a plurality of categories in which the work-product is to be rated”, and “a rating scale with which to evaluate said work-product”. These steps represent mere ideas in the abstract since no computer means or software embodied on a tangible medium exist for processing the steps of the claim. Since no computer means or software embodied on a tangible medium exist for processing the steps of the claim, claim 15, and all claims that depend from it, (claims 16-17) are therefore found to be non-statutory.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, claim 1, recites the steps of “reading a case prepared by the financial advisor, wherein said case provides recommendations”, “assigning a numerical value for said case in each of said plurality of areas based on said rating”. These steps do not produce a useful, concrete, and tangible result, since the numerical values are not objective criteria, but more of subjective human judgment. If one took these numerical values, punched them in a calculator, and came up with a number, then that result would be useful, concrete and tangible. However, since an additional step that would produce a tangible result does not exist, claim 1 and all claims that depend from it (claims 2-12) are therefore non-statutory.

In the present case, claim 13, recites the steps of recites the steps of “selecting a case prepared by the financial advisor, wherein said case provides recommendations”, “selecting a first assessor and a second assessor”, “rating said case in a plurality of areas by comparing said case to a predetermined standard”, “assigning a first numerical value for said case in each of said plurality of areas based on said rating by said first assessor”, “assigning a second numerical value for said case in each of said plurality of areas based on said rating by said second assessor”, “comparing said first numerical value to said second numerical value in one of said plurality of areas”. These steps do not produce a useful, concrete, and tangible result, since the numerical values are not objective criteria, but more of subjective human judgment. If one took these numerical values, punched them in a calculator, and came up with a number, then that result would be useful, concrete and tangible. However, since an additional step that would produce a tangible result does not exist, claim 13 and all claims that depend from it (claim 14) are therefore non-statutory.

In the present case, claim 15, recites the steps of recites the steps of “a plurality of categories in which the work-product is to be rated”, and “a rating scale with which to evaluate said work-product”. These steps do not produce a useful, concrete, and tangible result, since the numerical values are not objective criteria, but more of subjective human judgment. Since an additional step that would produce a tangible result does not exist, claim 15 and all claims that depend from it (claims 16-17) are therefore non-statutory.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations “a plurality of categories in which the work-product is to be rated” and “a rating scale with which to evaluate said work-product” both fail to suggest any apparatus structure or computer and therefore cannot be a system as disclosed in the preamble.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Havens (US 5,909,669).

As per claim 15, Havens discloses:

a plurality of categories in which the work-product is to be rated, (Col. 2, line 66- Col. 3, line 23, [information and work criteria broken down into applicability, understandability, etc.]);

and a rating scale with which to evaluate said work-product, (Col. 3, line 58-Col. 4, line 6, [scale]).

As per claim 16, Havens discloses:

wherein said rating scale consists of integers ranging from 1 to 5, (Col. 3, line 58-Col. 4, line 6, [inherent with citation since integers ranging from 1-10, includes integers ranging form 1-5]).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,909,669) as cited by applicant, and further in view of Tom (US 5,696,907), as cited by applicant.

As per claim 1, Havens discloses:

rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 3, lines 41-45, [qualitatively assessing information criteria],w/ Col. 1, lines 14-19, [assessing by comparing to a benchmark value]); and

assigning a numerical value for said case in each of said plurality of areas based on said rating, (col. 3, lines 46-49, [assigning a numeric value]).



Havens fails to disclose the evaluation of the performance of a financial advisor, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses a financial advisor in col. 2, lines 21-22 and lines 53-55, where the credit manager represents the financial advisor and since the credit manager is shown to evaluate financial service applications for approval, and the financial service applications is further evaluated by the system. Tom discloses this limitation in an analogous art for the purpose of showing that credit managers are involved in the processing of financial applications.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to evaluate the performance of a financial advisor with the motivation of analyzing and determining assessment values for workers in the financial industry.

As per claim 2, Havens discloses:

repeating said reading, rating, and assigning steps for a plurality of cases for the financial advisor being evaluated, (col. 2, lines 33-35, [shows a plurality of information criteria which represents a plurality of cases, Col. 4, lines 41-57, [conducting one or more surveys]]).

As per claim 3, Havens discloses:

wherein said repeating step is performed by a different person than said reading, comparing, and rating steps, (Col. 1, lines 23-27, [shows that managers/consultants

perform the assessment process, Col. 3, lines 41-49, [shows that workers perform the reading, comparing and rating steps by qualitatively assessing information criterion]).

As per claim 4, Havens discloses:

wherein said financial advisor is a member of a larger group of financial advisors, each group comprising a plurality of financial advisors, further comprising:

compiling data regarding the ratings of the group, (Col. 4, lines 30-40, [surveyed as a whole]).

As per claim 5, Havens discloses:

The method of claim wherein a higher numerical value indicates increased compliance with said predetermined standard, (Col. 3, line 62-col. 4, line 6, [where a rating of "10" means information must consistently be adequate for assigned tasks and a "1" means that they need not ever be relevant.

As per claims 6, 7, 17, Havens fails to disclose Financial Planning; Financial Position', Protection Planning', Disability', Life Insurance', Long-Term Care; Investment Planning', Tax Planning', Retirement Planning', Estate Planning', Communication', Overall rating/ Affordability of Retirement Planning Recommendation', Documentation of risk tolerance regarding retirement Planning', Exploration of tax ramifications of Retirement Planning Recommendation', Feasibility of Goal Achievement regarding Retirement Planning Recommendation', Overall rating of Retirement Planning section', Advice regarding wills, trusts, or other estate planning techniques', Advice regarding beneficiary designations and/or ownership issues; Advice regarding Estate Tax situation; Advice regarding the hiring of an estate planning attorney; Overall rating of

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Estate Planning section', Linkage of various financial planning areas to another; Organization and presentation', Statement of sources of information and/or assumptions; and Overall rating of the work-product...but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

Financial Planning; Financial Position', Protection Planning', Disability', Life Insurance', Long-Term Care; Investment Planning', Tax Planning', Retirement Planning', Estate Planning', Communication', Overall rating/ Affordability of Retirement Planning Recommendation', Documentation of risk tolerance regarding retirement Planning', Exploration of tax ramifications of Retirement Planning Recommendation', Feasibility of Goal Achievement regarding Retirement Planning Recommendation', Overall rating of Retirement Planning section', Advice regarding wills, trusts, or other estate planning techniques', Advice regarding beneficiary designations and/or ownership issues; Advice regarding Estate Tax situation; Advice regarding the hiring of an estate planning attorney; Overall rating of Estate Planning section', Linkage of various financial planning areas to another; Organization and presentation', Statement of sources of information and/or assumptions; and Overall rating of the work-product...(col. 2, lines 53-55, [analyzing {by another entity} the credit manager's previously approved analysis of financial service applications where financial service includes all of the above limitations]). Tom discloses this limitation in an analogous art for the purpose of showing that financial service applications can be used in the assessment process.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include all of the above financial limitations with the motivation of evaluating the performance of financial data.

As per claim 8, Havens discloses:

wherein said reading, rating, and assigning steps are completed by a plurality of people, (Col. 4, lines 31-41, [twenty workers]).

As per claim 9, Havens fails to disclose wherein said reading, rating, and assigning steps are completed by a plurality of financial advisors, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

wherein said reading, rating, and assigning steps are completed by a plurality of financial advisors, (col.2,lines 21-22, w/ lines 47-55, [credit managers who evaluate financial service applications]). Tom discloses this limitation to show that the credit managers are the ones that actually do the evaluating (of the financial applications)).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the reading, rating and assigning steps to be completed by a plurality of financial advisors with the motivation of showing that the evaluation is done by a network of advisors.

As per claim 10, Havens discloses:

wherein said reading, rating, and assigning steps are completed for each case in a subset of all cases produced by the financial advisor during a predetermined time period, (Col. 1, lines 27-29, [accessing for a selected time period]).

As per claim 11, Havens discloses:

The method of claim wherein said numerical value comprises a numerical rating that is an integer selected from the group consisting of 1, 2, 3, 4, and 5, and wherein: a numerical rating of 1 in a particular category indicates that the advice in that category is considered questionable', a numerical rating of 2 in a particular category indicates that the advice in that category is considered limited, a numerical rating of 3 in a particular category indicates that the advice in that category is reasonably informative with respect to any actions that are recommended', a numerical rating of 4 in a particular category indicates that the advice in that category details the reasons for the recommendation of a particular action and the manner in which an action should be performed; and a numerical rating of 5 in a particular category indicates that the advice in that category sufficiently provides an analysis of alternative courses of actions in addition to detailing the reasons for the recommendation of a particular action, (col. 3, lines 57-Col. 4, line 6, [where this scale represents the numerical rating since this scale represents ratings for the assessment of information criteria and definitions of what ratings stand for, only on a wider level]).

As per claim 12, Havens fails to disclose providing negative feedback to said financial advisor if said numerical rating in any of said plurality of categories is at least one of 1 and 2, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

providing negative feedback to said financial advisor if said numerical rating in any of said plurality of categories is at least one of 1 and 2, (Col. 6, lines 54--57, [negative influence representation before a contract is approved]). Tom discloses this limitation in an analogous art for the purpose of showing that before a contract is approved, some type of negative influence will be acknowledged.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide negative feedback with the motivation of providing the evaluator with information about the status of the performance.

As per claim 13, Havens discloses:

selecting a case prepared by the financial advisor, wherein said case provides recommendations, (Col. 3, lines 42-46, [the generated survey]);

selecting a first assessor and a second assessor, (col. 4, lines 41-56, [this feature is inherent with the cited passage since a first and second assessor must be selected in order for the surveys to surveys to be assessed at the same time]);

rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 3, lines 41-45, [qualitatively assessing information criteria],w/ Col. 1, lines 14-19, [assessing by comparing to a benchmark value]);

assigning a first numerical value for said case in each of said plurality of areas based on said rating by said first assessor, (Col. 11, lines 28-30, [one or more surveys generates rank segments]);

assigning a second numerical value for said case in each of said plurality of

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areas based on said rating by said second assessor, (col. 13, lines 3-4, [segmenting ranks into segments], w/ Col. 13, lines 18-20, [calculating comparison values from segments]), and

comparing said first numerical value to said second numerical value in one of said plurality of areas, (Col. 13, lines 37-40, [comparing comparison values for one or more surveys]).

Havens fails to disclose the evaluation of the performance of a financial advisor, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses a financial advisor in col. 2, lines 21-22 and lines 53-55, where the credit manager represents the financial advisor and since the credit manager is shown to evaluate financial service applications for approval, and the financial service applications is further evaluated by the system. Tom discloses this limitation in an analogous art for the purpose of showing that credit managers are involved in the processing of financial applications.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to evaluate the performance of a financial advisor with the motivation of analyzing and determining assessment values for workers in the financial industry.

As per claim 14, Havens discloses:

selecting an arbitrator, (Col. 15, lines 18-19, [inherent with retrieving survey data since an arbitrator is the one who needs to retrieve the selected survey data in order to make an assessment]);

rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 15, lines 20-26, [generating comparison value]).

assigning a third numerical value for said case in each of said plurality of areas based on said rating by said arbitrator, (col. 4, line 65-Col. 5, line 1, [ordinal variables]).

Havens fails to disclose finalizing said rating based on said third numerical value, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses finalizing said rating based on said third numerical value, (col. 5, lines 41-44, [final decision]). Tom discloses this limitation in an analogous art for the purpose of showing that a final decision with respect to the evaluation of a credit manager's assessment of a financial service application.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 703-305-1340. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238



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[After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.

June 14, 2004



TARIQ R. HAFIZ  
SUPERVISORY PATENT EXAMINER  
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